Paper No. 31 BAC

U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Intel Corporation

v.

Felicia Wheeler-Sweet

Opposition No. 96,517 to application Serial No. 74/427,409 filed on August 20, 1993

J. Paul Williamson of Arnold, White & Durkee for Intel Corporation.

Felicia Wheeler-Sweet, pro se.

Before Cissel, Chapman and Wendel, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

An intent-to-use application was filed by Felicia Wheeler-Sweet on August 20, 1993 to register the mark INTELIMETRIC INCORPORATED on the Principal Register for services described as "consulting in the field of computers and computer programming." Applicant disclaimed the term "INCORPORATED."

Intel Corporation has opposed registration of the mark, alleging that opposer offers and sells a wide variety of computer hardware and software under the trade name INTEL CORPORATION and the trademark INTEL; that opposer incorporated under the name INTEL CORPORATION in 1968 and has continuously done business in interstate commerce under that name to the present; that opposer has offered and sold computer software products under the trade name INTEL CORPORATION since 1989; that opposer has offered and sold a variety of computer hardware products under the trademark INTEL (and formatives thereof) continuously since 1969; and that applicant's mark, if used in connection with her services, would so resemble opposer's previously used trade name INTEL CORPORATION and opposer's various previously used and registered INTEL trademarks¹, as to be likely to cause confusion, mistake, or deception.

Applicant denied the salient allegations of the notice

¹ Opposer pleaded ownership of the following specific registrations ("among others") covering the mark INTEL: Reg. No. 938,772, issued July 25, 1972, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed (for 10 years on July 25, 1992), for "equipment for the testing and programming of integrated circuits, registers and semiconductor memories." The claimed dates of first use are January 15, 1971.

Reg. No. 939,641, issued August 1, 1972, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed (for 10 years August 1, 1992), for "integrated circuits, registers and semiconductor memories." The claimed dates of first use are March 11, 1969.

Reg. No. 1,022,563, issued October 14, 1975, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed (for 10 years on October 14, 1995), for "microcomputers,"



of opposition.

The record consists of the pleadings; status and title copies of opposer's three pleaded registrations and seven additional registrations submitted under a notice of reliance; the testimony, with exhibits, of Jonathan Sharp, opposer's "manager brand strategy"; and the testimony, with exhibits, of Michele Andreetta, a trademark specialist with opposer. Applicant submitted no evidence or testimony.²

Both parties filed briefs on the case.³ No oral hearing was requested.

As noted above, in this case opposer has filed status and title copies of ten registrations, including its three

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² Applicant did not attend opposer's depositions.

In opposer's reply brief, opposer moved to strike applicant's brief as untimely, or alternatively to strike applicant's exhibit B, attached to her brief. Applicant's brief was filed one day late. This delay is clearly de minimis in nature, and there is no prejudice to opposer. Opposer's motion to strike applicant's brief is denied. However, opposer's alternative motion to strike applicant's exhibit B (a search report listing of third-party applications and/or registrations) is granted. This information was not timely and properly made of record during trial. Further, third-party registrations may not be made of record simply by filing a copy of a list or a search report. See TBMP §703.02(b) and cases cited therein. We have not considered applicant's exhibit B.

Finally, on page 8 of opposer's reply brief, opposer requested that the Board take judicial notice of a copy of a computer screen printout of applicant's website (attached to the reply brief as exhibit A). Alternatively, opposer requested that the exhibit be considered as relating to the credibility of applicant's "unsubstantiated" allegations throughout her brief. Opposer's request that we take judicial notice of applicant's website is denied. This is not the type of fact which may be judicially noticed. See Fed. R. Evid. 201(b), and TBMP §712.01. Opposer's exhibit A attached to its reply brief was not considered in reaching our decision herein.

pleaded registrations for the mark INTEL⁴, as well as two other registrations for the mark INTEL.⁵ Opposer's other five registered marks are in the formats shown below:

Reg. Nos. 914,978 and $1,573,324;^6$

⁴ Reg. Nos. 938,772; 939,641; and 1,022,563, as more specifically identified in footnote 1.

⁵ Reg. No. 1,723,243, issued October 13, 1992, Section 8 affidavit accepted, Section 15 affidavit acknowledged, for "metal key rings," with claimed dates of first use of October 16, 1990; "watches," with claimed dates of first use of October 15, 1990; "note paper, note cards, posters, microprocessor chip die plot prints as art prints, pencils, ball point pens, ink pens and stationery folders," with claimed dates of first use of October 22, 1990; "plastic key chain tags," with claimed first use dates of October 19, 1990; "mugs and water bottles sold empty," with claimed dates of first use of October 1, 1990; and "jigsaw puzzles, golf balls, golf tees and golf ball markers," with claimed dates of first use of September 27, 1990.

Reg. No. 1,725,692, issued October 20, 1992, Section 8 affidavit accepted, Section 15 affidavit acknowledged, for "all purpose sport bags, gym bags and carry-on bags," with claimed dates of first use of October 12, 1990; "towels," with claimed dates of first use of October 27, 1990; and "clothing, namely, t-shirts, coveralls, shirts and caps," with claimed dates of first use of October 1, 1990.

⁶ Reg. No. 914,978, issued June 15, 1971, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed (for 10 years on June 15, 1991), for "integrated circuits, registers and semiconductor memories," with claimed dates of first use of March 11, 1969; and Reg. No. 1,573,324, issued December 26, 1989, Section 8 affidavit accepted, Section 15 affidavit acknowledged, for "printed material, namely, technical manuals, pamphlets, user and product manuals, all of which relate to the field of information and data technology and semiconductor devices," with claimed dates of first use of August 1, 1973.

INTEL INSIDE

Reg. No. 1,702,463;⁷ Reg. No. 1,705,796;⁸ and

Reg. No. 1,945,531.9

Because opposer owns valid and subsisting registrations 10 of its pleaded marks, the issue of priority

⁷ Reg. No. 1,702,463, issued July 21, 1992, Section 8 affidavit accepted, Section 15 affidavit acknowledged, for "microprocessors," with claimed dates of first use of January 1992.

⁸ Reg. No. 1,705,796, issued August 4, 1992, Section 8 affidavit accepted, Section 15 affidavit acknowledged, for "microprocessors," with claimed dates of first use of January 1992.

⁹ Reg. No. 1,945,531, issued January 2, 1996, for "computer" hardware and peripherals therefor, cameras and headsets, and computer software, for facilitating conferences among persons in different locations through the transfer of voices and visual images of participants and through the transfer of data among the participants," with claimed dates of first use of January 31, 1994.

¹⁰ Status and title copies of four of the above-identified registrations (Reg. Nos. 1,702,463; 1,705,796; 1,723,243 and 1,725,692) submitted with opposer's notice of reliance were prepared by the Patent and Trademark Office in February 1997, and therefore do not include information as to the Section 8 affidavits, which were due on four separate dates in 1998. When a registration owned by a party has been properly made of record in an inter partes case, and there are changes in the status of the registration between the time it was made of record and the time the case is decided, the Board will take judicial notice of,

does not arise. See King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and Humana Inc. v. Humanomics Inc., 3 USPQ2d 1696 (TTAB 1987). Moreover, the evidence clearly shows that opposer's first use preceded the filing date of applicant's intent-to-use application.

Thus, the sole issue before the Board is likelihood of confusion. Based on the record before us in this case, we find that confusion is likely.

Opposer corporation was founded in 1968 "to pursue business opportunities around the integrated circuit" (Sharp Dep., p. 15) and opposer's initial areas of focus were on memory devices. In 1971 opposer introduced its first microprocessor, and in 1980 IBM used that as the basic microprocessor in the IBM personal computer. Thus, by the 1980s opposer had shifted its business focus to logic products, such as the microprocessor; and by the end of the 1980s opposer had again shifted business focus to the personal computer business. Opposer's microprocessor remains a significant portion of opposer's business, but opposer makes "many other components that go into PC [personal computer] systems" (Sharp Dep., p. 18). Also,

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and rely upon, the current status of the registration as shown by the records of the Patent and Trademark Office. See TBMP $\S703.02(a)$, at page 700-10, and the cases cited therein. The Board hereby takes judicial notice of the current status of the four involved registrations.

opposer develops new products for the PC platform including Internet cards, network management, and software, all sold under the INTEL marks and INTEL INCORPORATED trade name.

Opposer sells its products to computer suppliers such as IBM, and other "embedded application-type manufacturers such as computer numerically controlled machines and other devices requiring electronic support." (Sharp Dep., p. 16).

In addition, opposer sells products, such as overdrive processors and video phone and video conferencing type products, directly to PC users. Throughout the 1990s opposer's target audience has grown much broader, due to the expansion of the personal computer industry. Opposer considers its target audience to be all people over the age of twelve, essentially anyone who could purchase a PC.

Jonathan Sharp testified that opposer is also engaged in the business of consulting with respect to computers and computer programming in various ways. Opposer's employees educate and train students and teachers on technology subjects especially relating to the personal computer. Opposer develops markets for new technologies by working with industry people including independent hardware vendors and independent software vendors, providing technical advice and software programming capability. Opposer also provides technical support and assistance getting opposer's video

conferring products installed and running, as well as addressing issues that arise in the use of the product.

Opposer has between 1000-2000 licensees of its INTEL INSIDE Program. These licensees spend hundreds of millions of dollars advertising the INTEL INSIDE marks, and they place point-of-purchase materials bearing the various INTEL marks in over 2,500 retail outlets worldwide (e.g., Circuit City, Best Buy, Comp U.S.A.).

Mr. Sharp testified that INTEL microprocessors are in 80% of the desk-top computers now in use. He further testified that opposer's worldwide sales of its products sold under its various INTEL marks were \$11 billion in 1994, \$16 billion in 1995, and \$20 billion in 1996. Advertising expenditures for the same years worldwide were between \$300 and \$600 million in 1994, just under \$650 million in 1995, and over \$650 million in 1996, with approximately 50% of those expenditures in the United States alone.

The record shows that opposer advertises its various products through radio, television (e.g., "Super Bowl," "Seinfeld," "Friends," "Star Trek: Next Generation," as well as MTV and Discover channels); print advertising including trade publications (e.g., PC Week, PC Magazine, Byte) and general interest publications (e.g., National Geographic, Wall Street Journal); and on the Internet through its own website as well as advertising on third-party websites. In

addition, opposer sponsors civic events such as the promotion of the Smithsonian Institution's 150th anniversary.

In studies carried out in the United States by opposer to ascertain awareness of the INTEL and INTEL INSIDE brands, there was an 80% awareness of the brand among businesses and individuals who purchase PCs. In a 1995 study by a market research company conducted a study in which they analyzed, inter alia, the premium that people would pay on a typical PC system price in order to get their brand of choice on certain elements of the PC, and the premium purchasers would pay for the INTEL brand microprocessor was over \$300. The record also shows that opposer's trademarks and trade name have regularly appeared, unsolicited, in stories in trade as well as general publications.

According to her application, applicant is located in the Washington, D.C. metropolitan area, and she intends to offer consulting services relating to computers and computer programming. Applicant has not furnished any evidence regarding her business or her activities under the mark. This is consistent with the fact that the application was filed based on applicant's claim that she intended to use the mark.

Our determination of likelihood of confusion must be based on our analysis of all of the probative facts in

evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

The first relevant *du Pont* factor is the similarity or dissimilarity of the marks. Marks must be considered in their entireties; but in articulating reasons for reaching a conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more significance than another. See In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In applicant's mark the word INCORPORATED is of little significance. Opposer's trade name INTEL CORPORATION and its various marks including INTEL, INTEL INSIDE and INTEL PROSHARE, and applicant's mark INTELIMETRIC INCORPORATED all include the root term INTEL. Although there are differences in appearance between applicant's mark and opposer's marks and trade name, there are significant similarities in that the parties' marks each start with INTEL as the first two syllables. Often the first part of a mark is the most likely part to be impressed upon the mind of the purchaser and remembered. See Presto Products Inc. v. Nice-Pak Products Inc., 9 USPQ2d 1895, 1997 (TTAB 1988). Here

INTELIMETRIC incorporates the root word, INTEL, from opposer's registered marks and opposer's trade name. Thus, the common significant element in the parties' marks is the same arbitrary element, INTEL. See L. & C. Hardtmuth, Inc. v. Fabrique Suisse de Crayons Caran D'Ache S.A., 287 F.2d 599, 129 USPQ 103 (CCPA 1961). Moreover, while applicant's mark is presented for registration in typed form, applicant could alter the actual presentation of the mark at any time by altering the style and/or size of the lettering, or highlighting or capitalizing the first two syllables of the term (i.e., INTELIMETRIC or IntelImetric) thereby increasing the emphasis on the first two syllables of the term. See Jockey International Inc. v. Mallory & Church Corp., 25 USPQ2d 1233 (TTAB 1992). We find that the marks are similar in sound and appearance.

The second relevant du Pont factor is the relatedness of the goods and/or services, as described in the application or registration(s), or in connection with which opposer has shown prior use of its mark or trade name. It is well settled that the involved goods/services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that they are related in some manner or that the circumstances surrounding their marketing are such that they would be

likely to be encountered by the same persons under situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer, or that there is an association between the producers of the goods or services. See In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991), and In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978). Of course, there is no per se rule relating to likelihood of confusion in the computer field. See In re Quadram Corp., 228 USPQ 863 (TTAB 1985).

Opposer's goods encompass a wide variety of computerrelated products (e.g., microprocessors, microcomputers,
computer software, technical manuals and user and product
manuals all relating to data technology and semiconductor
devices, and computer hardware and peripherals therefor), as
well as collateral products (e.g., plastic key chain tags,
watches, jigsaw puzzles, towels, and clothing including tshirts and caps). In addition, opposer has established that
it provides consultation services involving education,
innovation and technical support (questions which arise from
the use of opposer's computer products). The services set
forth in the application are consulting services in the
field of computers and computer programming. We find that
opposer's goods and services and the services identified in
the opposed application are related. See Peopleware

Systems, Inc. v. Peopleware, Inc. 226 USPQ 320 (TTAB 1985) (PEOPLEWARE for consulting services in the field of computer selection, usage, design and development held to be confusingly similar to PEOPLEWARE for services involving the design, testing, and manufacture of microprocessor-based computer hardware and software products); and In re Epic Systems Corporation, 228 USPQ 213 (TTAB 1985) (EPIC for computer time-driven relational data base programs and related documentation held to be confusingly similar to EPIC DATA for electronic data collection terminals and electronic data collection units).

Purchasers may assume, upon encountering applicant's computer consulting services, that opposer is now offering these specific consulting services through applicant as a licensee, or the services are in some way sponsored by or associated with opposer. See Seligman & Latz, Inc. v. Merit Mercantile Corporation, 222 USPQ 720 (TTAB 1984).

The next relevant *du Pont* factors are the channels of trade and the similarity of purchasers. The Board must determine the issue of likelihood of confusion on the basis of the goods/services as identified. See Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994). Although applicant asserted in her brief that she will sell only to corporations, and will

not sell to the general public, there are no such limitations in applicant's application. Therefore, the services set forth in applicant's application must be presumed to move through all normal channels of trade and are available to all potential customers. See In re Elbaum, 211 USPQ 639 (TTAB 1981). Computer products, and consulting services in the field of computers and computer programming, with no restrictions, would normally be offered through similar, if not identical, channels of trade.

The next du Pont factor we look at in this case, the fame of the opposer's marks, is clearly established in opposer's favor. With recent annual worldwide sales exceeding \$20 billion dollars, recent annual United States advertising figures of \$325 million, and a showing that over 80% of PC buyers recognize the INTEL brand name, there is no question that opposer has established the fame of its involved marks for computer products. This record establishes that, given opposer's advertising and sales figures, opposer is a major player in the computer business, and that its INTEL and INTEL INSIDE marks for its various computer-related goods are famous. Thus, opposer's marks "enjoy a wide latitude of legal protection." See Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). See also, Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc., 889 F.2d 1070, 12

USPQ2d 1901 (Fed. Cir. 1989); and Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

The fame of opposer's marks increases the likelhood that consumers will believe that applicant's services emanate from or are sponsored by the same source.

Applicant's argument that there is no evidence of actual confusion is not persuasive. In this case applicant's application is based on her intent to use the mark, and she submitted no evidence of actual use. Even assuming applicant has commenced use of her mark in connection with her involved services, there is no evidence of the extent of such activities. Under the circumstances this case presents, we simply cannot conclude that there has been an opportunity for confusion to occur. Moreover, the test is not actual confusion, but likelihood of confusion. See Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992).

Applicant, as the newcomer, had the obligation to select a mark which would avoid confusion. See In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Based on the similarities in the parties' marks, the fame of opposer's marks, the relatedness of opposer's goods and services with the services specified in the application,

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and the similarity of the trade channels, we simply have no doubt that applicant's use of her mark for her services would be likely to cause confusion, mistake, or deception with opposer's marks, as well as opposer's trade name, as used on and in connection with opposer's various goods and services.

Decision: The opposition is sustained, and registration to applicant is refused.

- R. F. Cissel
- B. A. Chapman
- H. R. Wendel Administrative Trademark Judges, Trademark Trial and Appeal Board